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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/993,309	11/16/2001	Kristopher W. Gerulski	J-3047A	1717

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EXAMINER

PETERSON, KENNETH E

ART UNIT	PAPER NUMBER
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3724

DATE MAILED: 09/09/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/993,309

Applicant(s)

GERULSKI ET AL.

Examiner

Kenneth E Peterson

Art Unit

3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 11-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 3724

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-3,5-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Hurh, who shows a wound film dispenser with all of the recited limitations including a base having a bottom wall (22) having an angled retention wall (26c) with an arcuate aperture (28) and an angled bracing flap (26b) extending from a topside thereof. Hurh further shows a back wall (16) having a major flap (12) and a front wall (34) having a minor flap (36). It is noted that the Hurh dispenser is a handheld device often used in several different orientations, and thus there are different situations where different surfaces would be considered the bottom, front and back sides.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hurh, who shows a wound film dispenser with most of the recited limitations as set forth above.

Hurh does not state what kind of material his container is made out of. Examiner takes Official Notice that it is well known to make wound film dispensers out of single-

ply chipboard. It would have been obvious to one of ordinary skill in the art to have made Hurh's container out of single-ply chipboard, as is well known, in order to cheaply manufacture it.

Hurh's angled bracing flap (26b) is not wedge shaped. However, in the art of making containers from sheets of cardboard, Examiner takes Official Notice that it is well known to bevel various flaps, thus making them wedge-shaped, in order to ease assembly of the device. A prime example of this is shown by Hurh himself with flaps 17 and 36. It would have been obvious to one of ordinary skill in the art to have made Hurh's angled bracing flap (26b) be wedge-shaped, as taught by Hurh himself, in order to ease the assembly of the container (less prominent corners to catch on one another).

Currently, claim 1 requires that the retention wall *extend* from the bottom wall into the interior channel. Claim one does not state that the retention wall is *attached* to the bottom wall. Hurh's retention wall does, in fact, *extend at an angle*, from any of the walls, front back or bottom. Even if Applicant rewrote claim 1 to specifically state that the retention wall was attached to the bottom wall that is opposite the lid wall, then it is noted that the courts have long held it to be obvious shift the location of parts if the operation of the device is not thereby modified (in re Japikse, 86 USPQ 70). In this case, it would have been obvious to have attached the retention wall to any of the front, back or bottom walls, since operation of the device would not thereby be modified. Note that the device operates with the lid closed and that if the retaining wall was moved to panel 16, then the retention wall brace would abut the lid panel 34 and function normally.

Furthermore, Examiner takes Official Notice that devices such as Hurh's commonly operate with the panel 22 as the bottom wall. Note the position of blade 58, which would not be usable if the device was placed centrally on a countertop and panel 16 was the bottom wall. From this, it can be seen that those using the device centrally on a countertop would often choose to employ panel 22 as the bottom wall, and there are teachings available for proofing this.

5. Applicant's arguments have been fully considered but they are not persuasive.

Applicant argues against the 102 rejection by Hurh, stating that it is improper to consider Hurh's panel 22 to be the bottom wall. However, as shown above, it is common for this device to be employed with panel 22 on the bottom, and therefore it is not inappropriate to call panel 22 the bottom panel. Furthermore, the selection of which panel to attach the retaining wall to is up to the manufacturing engineer, since the device would function equally well with the retaining wall attached to the front, back or bottom wall.

Applicant's arguments against the 103 rejection by Hurh were also unpersuasive, since Hurh himself suggests the beveling of the flaps.

This field is crowded with art, and Applicant is going to have to use more specific language if a distinguishing claim is to be found. There are several things that Applicant could do to advance prosecution in the case. Firstly, Applicant's could claim that the retaining wall is *attached* to the bottom wall. Secondly, Applicant could claim a lid wall, and recite that the bottom wall is opposed to the lid wall. These two things would knock

out Hurh as a 102 rejection. Thirdly, Applicant could recite a fold line where the brace meets the retaining wall, and recite that the fold line is generally perpendicular to bottom wall.

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth Peterson whose telephone number is 703-308-2186. The examiner can normally be reached on Monday-Thursday, 7:30-4:30. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan Shoap can be reached at 703-308-1082.

All responses are encouraged to be by fax at 703-872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

kp

08-Sep-03



KENNETH E. PETERSON
PRIMARY EXAMINER